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In re Application of
BURKE *et al*
U.S. Application No.: 10/567,635
PCT No.: PCT/US2004/025005
Int. Filing Date: 03 August 2004
Priority Date: 08 August 2003
Docket No.: 257122/0092
For: IMPROVED ANTHELMINTIC
FORMULATIONS

DECISION

This is a decision on the papers filed 12 February 2007 and 19 March 2007.

BACKGROUND

On 08 February 2006, applicants filed papers to enter the national phase of PCT/US2004/025005 pursuant to 35 U.S.C. 371. Stroock & Stroock & Lavan LLP ("Stroock") filed the national stage papers for applicants and is listed as the correspondence address.

On 12 July 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee were required. Applicants were given two months to respond with extensions of time available.

On 12 February 2007, a response was filed which was accompanied by, *inter alia*, a Power of Attorney naming Bracewell & Giuliani LLP ("Bracewell") as counsel of record; a five-month extension and fee; an executed declaration; a copy of an assignment; a surcharge fee; a "Statement of Added Inventor Hepler Under 37 CFR 1.497(d)(1)"; a "Petition Regarding Unavailable or Uncooperative Inventors"; and authorization to charge any required fee to Deposit Account No. 50-0259.

On 19 March 2007 (and again via facsimile on 23 March 2007), applicants filed a "Petition to Revoke Power of Attorney and Appoint New Agent Under 37 CFR 1.182" which also contained a "Declaration of Max C. Marks in Support of 37 C.F.R. § 1.182 Petition" and authorization to charge any required fees to Deposit Account No. 19-4709.

DISCUSSION

The international publication ("WO/2005/016357") records the inventors on the underlying international application (PCT/US2004/025005) as Michael P. Burke, Vinay Tripathi, Albert Ahn and Ian William Cottrell. Hartz Mountain Corporation ("Hartz") and Virbac Corporation ("Virbac") each claim a 50% interest in the subject application as joint assignees.

In the papers filed on 12 February 2007, applicants request to modify the ownership of the subject application and change the inventive entity to Douglas I. Hepler, Joseph M. Lockhart, Ian William Cottrell and Albert Ahn. A Power of Attorney signed by Max C. Marx of Hartz and Jean M. Nelson of Virbac appointing Bracewell as counsel of record was provided. Applicants claim that Michael Burke and Viney Tripathi should be removed and Douglas I. Hepler and Joseph M. Lockhart be added as inventors. Applicants also assert that Mr. Cottrell and Mr. Ahn are refusing to cooperate.

In the papers filed by Stroock on 23 March 2007, Mr. Marx of Hartz requests to revoke their Power of Attorney appointing Bracewell and replace with Stroock as counsel. Mr. Marx, Corporate General Counsel and Corporate Secretary of Hartz, claims that 12 February 2007 filing violated the agreement between Hartz and Virbac by filing these documents without their consent. Mr. Marx also disagrees with the proposed changes to the inventive entity in the subject application and that joint inventors Mr. Cottrell and Mr. Ahn are refusing to cooperate.

The following items will be discussed in this decision: (1) change of correspondence address; (2) change of inventors; and (3) refusal of inventors to cooperate.

Change of Correspondence Address

The Power of Attorney filed on 12 February 2007 was signed by Mr. Marx of Hartz in his position as Corporate General Counsel & Corporate Secretary of Hartz and Jean M. Nelson of Virbac. The position of Corporate Secretary is a position presumed to have authority to sign for an organization. See § 324 MPEP. However, the position of Ms. Nelson of Virbac is unreadable on the Power of Attorney. Therefore, Ms. Nelson cannot be presumed to have authority to sign the submission on behalf of the assignee by her position. Ms. Nelson also has not set forth that she is authorized (or empowered) to act on behalf of the assignee, nor has applicants submitted a copy of a resolution showing that Ms. Nelson is empowered to sign the submission on behalf of Virbac.

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For these reasons, the change off correspondence address to Bracewell is ineffective. See § 601.03 MPEP.¹ The correspondence address submitted with the original filing remains effective. 37 CFR 1.33(a).

Mr. Marx of Hartz also submitted a revocation of the Power of Attorney appointing Bracewell and has appointed Stroock to represent their interests. A petition under 37 CFR 1.182 is not required.

Request to Change Inventors

Applicants claim that Michael Burke and Viney Tripathi should be removed as inventors and Douglas I. Hepler and Joseph M. Lockhart be added as inventors. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Here, the processing fee of \$130.00 has been charged to Deposit Account No. 50-0259 as authorized. Applicants filed a statement by Douglas Hepler who requests to be added as an inventor in the above-captioned application. Mr. Hepler states that the error in inventorship "occurred without deceptive intention on my part." However, applicants have not provided the requisite statements by Mr. Burke, Mr. Tripathi and Mr. Lockhart. Applicants have also not submitted a written consent of assignees as required.

Therefore, all the requirements of 37 CFR 1.497(d) are not yet complete.

¹ § 601.03 MPEP ("If an application is filed by a company to whom the invention has been assigned or to whom there is an obligation to assign the invention, a person who has the authority to act on behalf of the company may change the correspondence address.")

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It is noted that section 201.03 discusses situations where the statement from the inventor to be added or removed cannot be obtained and is applicable to petitions under 37 CFR 1.497(d). It states in the relevant section:

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. **Every existing assignee of the original named inventors must give its consent to the requested correction.** Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown . . .

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications.

Petition Under 37 CFR 1.47(a)

Applicants claim that Albert Ahn and Ian Cottrell are refusing to cooperate in the above-identified application and have filed a petition under 37 CFR 1.47 in response to the Form PCT/DO/EO/905 mailed 12 July 2006.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

The petition fee of \$200.00 has been charged to Deposit Account No. 50-0259 as authorized. Due to the unresolved questions regarding the correct inventive entity and purported refusal to cooperate by Mr. Ahn and Mr. Cottrell in the subject application, further discussion on this petition will be suspended until those matters are resolved.

Applicants should note, however, that section 409.03(d) of the MPEP discusses

the factual proof required to show a refusal to cooperate and states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In the papers filed 12 February 2007, applicants did not provide the required statement of facts, or sufficient documentary evidence to meet this requirement.

CONCLUSION

For the reason discussed above, applicants' request under 37 CFR 1.497(d) and 37 CFR 1.47(a) are both **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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